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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,428	03/31/2004	Paul Buchheit	60963-5007	8809
24341 7590 10/31/2007 MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			EXAMINER NGUYEN, DUSTIN	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,428	Applicant(s) BUCHHEIT ET AL.	
	Examiner Dustin Nguyen	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/13/2004, 06/24/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 45-81 are presented for examination.

Claim Objections

2. Claims 49, 50, 59, 61, 70, and 79 are objected to because of the following informalities: “the list” should be corrected as “the list of conversations”. Appropriate correction is required.
3. Claims 54, 65, and 74 are objected to because of the following informalities: “the unique subset” should be corrected as “the unique subset of the plurality of electronic messages”. Appropriate correction is required.
4. Claim 69 is objected to because of the following informalities: “The method” should be corrected as “The system”. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 61-69 and 81 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It appears claims 61, 68 and 81 would reasonably be interpreted by one of ordinary skill as a system of software per se, failing to fall within a statutory category of invention. Applicants' disclosure contains no explicit and deliberate definition for the term "module", and in the context of the disclosure and claims in question, one of ordinary skill would reasonably interpret the modules as software applications. As such, the system of modules, software, alone is not a machine, and it is clearly not a process, manufacture nor composition of matter [Please see MPEP 2106].

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 45, 46, 49-57, 59-66, 68-75, 77-81 are rejected under 35 U.S.C. 102(b) as being anticipated by Douglas E. Comer and Larry L. Peterson, "Conversation-Based Mail" [hereinafter as Comer].

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8. As per claim 45, Comer discloses the invention as claimed including a method for searching messages in a conversation-based message system [i.e. conversation-based mail] [page 1, lines 7-13], comprising:

receiving a query from a requestor [i.e. query conversation] [page 8, lines 20-29; and page 17, lines 28-36];

transmitting the query [i.e. submit message to a conversation] [page 3, lines 38-40; and page 18, lines 15-17] to a conversation management system [i.e. message management] [page 3, lines 34-page 4, lines 18];

receiving from the conversation management system a list of conversations [page 4, lines 20-31; and page 6, lines 44-page 7, lines 15], each of the conversations in the list having a respective conversation identifier [i.e. identifier that is associated with the conversation] [page 8, lines 34-36], and wherein each conversation comprises one or more messages sharing a common set of characteristics that meet first predefined criteria [i.e. topic] [page 3, lines 20-31; page 4, lines 1-5; and page 8, lines 35-page 9, lines 12]; and

presenting at least a portion of the list of conversations to the requestor [i.e. display] [page 9, lines 30-page 10, lines 19].

9. As per claim 46, Comer discloses wherein the conversations are presented to the requestor in an order determined in accordance with second predefined criteria [i.e. display in order] [page 9, lines 37-46].

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10. As per claim 49, it is rejected for similar reasons as stated above in claims 45 and 46.

Furthermore, Comer discloses receiving from the messaging system a plurality of messages, each message having a unique message identifier and belonging to a respective conversation [i.e. unique-id] [page 9, lines 34-36]; generating a plurality of conversations [i.e. categories of conversations] [page 9, lines 21-29], each conversation including a respective conversation identifier and unique subset of the plurality of messages [page 12, lines 38-42]; and each conversation being represented as a single item in the list [page 9, lines 30-34].

11. As per claim 50, it is rejected for similar reasons as stated above in claims 45, 46 and 49.

Furthermore, Comer discloses selecting a list of conversations from the plurality of conversations in accordance with a predefined query [page 7, lines 1-6; and page 18, lines 28-36].

12. As per claim 51, Comer discloses wherein the respective conversation identifier is distinct from a subject reference of the message [page 9, lines 34-36].

13. As per claim 52, Comer discloses wherein the respective conversation identifier is based in part on information not including a subject reference of the message [page 13, lines 17-34].

14. As per claim 53, Comer discloses wherein each conversation comprises messages

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sharing a common set of characteristics that meet second predefined criteria [i.e. relationship among messages] [page 4, lines 1-5].

15. As per claim 54, Comer discloses wherein the second predefined criteria include having a close temporal relationship among the unique subset [page 8, lines 19-35].

16. As per claim 55, Comer discloses wherein the common set of characteristics include the subject reference of the messages and at least one characteristic of the messages other than the subject reference [page 3, lines 24-34].

17. As per claims 56 and 57, they are rejected as stated above in claims 45 and 46.

18. As per claims 59 and 60, they are rejected for similar reasons as stated above in claims 50 and 51.

19. As per claims 61-66, they are rejected for similar reasons as stated above in claims 50-54.

20. As per claims 68 and 69, they are rejected for similar reasons as stated above in claim 45. Furthermore, Comer discloses at least one message relevant to the query [page 7, lines 1-6; and page 18, lines 28-36].

21. As per claims 70-75, they are rejected for similar reasons as stated above in claims 50-54.

22. As per claim 77, it is rejected for similar reasons as stated above in claim 68.
23. As per claim 78, it is rejected for similar reasons as stated above in claim 46.
24. As per claims 79 and 80, they are rejected for similar reasons as stated above in claims 50 and 51.
25. As per claim 81, it is rejected for similar reasons as stated above in claim 45.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 47, 48, 58, 67 and 76 rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas E. Comer and Larry L. Peterson, "Conversation-Based Mail" [hereinafter as Comer], in view of Kennedy [US Patent No 6,330,589].

28. As per claim 47, Comer does not specifically disclose wherein the second predefined criteria includes a date/time value of a most recently received message of a respective

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conversation. Kennedy discloses wherein the second predefined criteria includes a date/time value of a most recently received message of a respective conversation [i.e. posted time] [Figures 5, 6a, 6b, 7a-7j; and col 12, lines 14-26]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Comer and Kennedy because the teaching of Kennedy would enable to support efficient management of conversations so that conversation roots and nested replies are presented sequentially [Kennedy, col 2, lines 61-64].

29. As per claim 48, Kennedy discloses wherein the second predefined criteria includes a date/time value of a most recently received message of a respective conversation relevant to the search query [Figures 5, 6a, 6b, 7a-7j; col 13, lines 66-col 14, lines 12; and col 16, lines 7-23].

30. As per claim 58, it is rejected for similar reasons as stated above in claim 47.

31. As per claim 67, it is rejected for similar reasons as stated above in claim 47.

32. As per claim 76, it is rejected for similar reasons as stated above in claim 47.

33. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for

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response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

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A handwritten signature in black ink, appearing to read 'Dustin', is written over the printed name and title.